

RECEIVED
CENTRAL FAX CENTER

MAR 05 2007

REMARKS

The Examiner issued a Final Office Action in this application on April 24, 2006, in which he indicated that claims 8-10 were allowable, claim 15 was objected to, and claims 1-4, 6, 7, 11-14 and 16 were rejected. In response to the Examiner's Final Office Action, Applicants filed an Amendment Under 37 CFR §1.116 on October 24, 2006, canceling all rejected claims (claims 1-4, 6, 7, 11-14 and 16) and amending objected-to claim 15 to place it into condition for allowance by re-writing it into independent form to include the content of the claims 11 and 12. Claims 8-10, being indicated to be allowable by the Examiner, were not amended. It is therefore respectfully submitted that Applicants, by these amendments, placed the application into condition for allowance.

Applicants' Amendment Under 37 CFR §1.116 was filed on October 24, 2006 with a request for a three month extension of time, including the fee required under 37 CFR §1.17(a)(3). Therefore, Applicants' response to the Final Office Action was timely filed on the six month response due date.

On November 16, 2006, the Examiner issued an Advisory Action refusing to enter Applicants' Amendment Under 37 CFR §1.116 with the following statement: "The proposed amendment(s) filed after a final rejection, but prior to a date of filing a brief, will not be entered because they raise new issues that would require further consideration and/or search (see NOTE below)." Applicants address each of the allegations made by the Examiner below.

A. The Examiner alleged that Applicants had failed to disclose a dissertation of one of the inventors which the Examiner apparently discovered in an internet search.

The Examiner alleges that the dissertation by co-inventor Juri Jatskevich entitled "A State Selection Algorithm for the Automated State Model Generator" (hereinafter "the Jatskevich Dissertation") is prior art material to the examination of the present application that Applicants failed to submit to the Examiner. It is respectfully submitted that the Jatskevich Dissertation is not prior art to the present application.

As detailed in the Affidavit of Troy J. Cole (the undersigned) filed herewith, although the Jatskevich Dissertation itself is dated "August 1999," the Thesis Acceptance cover sheet included on the copy provided by the Examiner is clearly marked "This thesis is to be regarded as confidential." Cole Affidavit, para. 4. Furthermore, the publisher of the dissertation copy obtained by the Examiner, ProQuest, has certified that the Jatskevich Dissertation was received by that company on September 14, 2001 and the publication process was completed on November 1, 2001. Cole Affidavit, para. 6. As the present application was filed January 11, 2002 and claims priority from a provisional application filed January 11, 2001, the Jatskevich Dissertation is clearly not prior art and Applicants therefore were under no duty to submit it to the Patent Office.

B. The Examiner additionally alleged that Applicants failed to submit a copy of the Search Report corresponding to related application WO/2002/056145.

The International Search Report was issued on August 1, 2002 and cited the following four references:

U.S. Patent No. 5,949,992 to Kundert
U.S. Patent No. 5,550,760 to Razdan et al.
U.S. Patent No. 5,467,291 to Fan et al.
U.S. Patent No. 5,469,366 to Yang et al.

Page 7 of 11

Serial No. 10/043,981
Group Art Unit 2128
Conf. No. 8469

Applicants cited the Radzan et al. and Fan et al. references to the Examiner in their Information Disclosure Statement dated April 11, 2002 (3 ½ months before issuance of the International Search Report). These references were considered by the Examiner, as indicated in the initialed copy returned to Applicants with the Office Action dated August 18, 2005.

The Kundert and Yang et al. references were not submitted to the Examiner, as no Information Disclosure Statement was submitted to the Examiner in response to the issuance of the International Search Report. It is respectfully submitted that failure to cite these references to the Examiner was caused by a clerical error.

As detailed in the Affidavit of Matthew R. Schantz filed herewith, Mr. Schantz was responsible for prosecution of the present application from the filing of the present application until he resigned from the partnership of Woodard, Emhardt, Moriarty, McNett & Henry LLP on April 15, 2005. See Schantz Affidavit paragraph 2. It was Mr. Schantz's routine procedure to automatically cite in a U.S. patent application all references cited in an International Search Report issued in a related international application. See Schantz Affidavit paragraph 3. Mr. Schantz has stated that his failure to do so in the present application was unintentional and must have arose through clerical error. See Schantz Affidavit paragraph 5.

It is worth noting that Applicants made no amendments in the related International application in response to the International Search Report. In the International Preliminary Examination Report issued on December 1, 2002, no claims were rejected in view of this prior art.

Nevertheless, Applicants would like to have the Kundert and Yang et al. references considered by the Examiner in the present application, and they are cited in Applicants' Supplemental Information Disclosure Statement submitted herewith.

C. The Examiner additionally alleged that Applicants failed to submit copies of the references incorporated in the application specification.

There are four documents mentioned in Applicants specification. Applicants will discuss each of them in turn below.

The Jatskevich Dissertation is mentioned on page 3, lines 14-15 of the specification. As discussed hereinabove, the Jatskevich Dissertation is not prior art and Applicants therefore had no duty to submit it to the Examiner.

An article styled as "O. Wasynczuk and S.D. Sudhoff, 'Automated State Model Generation Algorithm for Power Circuits and Systems,' IEEE Transactions on Power Systems, Vol. 11, No. 9, November, 1996, pp. 1951-1956" is mentioned on page 2, lines 26-28. This reference was considered by the Examiner, as evidenced by the Notice of References Cited PTO-892 included by the Examiner with his Office Action dated August 18, 2007. It is respectfully submitted that Applicants were under no duty to submit a reference already cited by the Examiner.

Two mathematics textbooks styled as "T.H. Cormen, C.E. Leiserson, R.L. Rivest, Introduction to Algorithms, MIT Press, McGraw Hill, 1993; and R.E. Tarjan, Data Structures and Network Algorithms, Bell Laboratories, Murray Hill, 1983" are mentioned on page 93, line 31 through page 94, line 1. It is respectfully submitted that these are basic mathematical textbooks and are not considered material to the examination of the

present application, which is directed to particular systems and methods of circuit simulation.

It is therefore respectfully submitted that the only incorporated reference that may have been material to the examination of the present application was considered by the Examiner during the Examination process.

D. Applicants' Amendment did not Raise New Issues and Should Properly be Entered.


It is respectfully submitted that none of the issues in sections A-C above and first brought forward by the Examiner in his Advisory Action, were raised by Applicants' Amendment Under 37 CFR §1.116 as alleged by the Examiner. These issues were raised *sua sponte* by the Examiner and do not relate to anything contained in Applicants' Amendment Under 37 CFR §1.116.

Because Applicants' Amendment Under 37 CFR §1.116 did not raise these new issues, Applicants' Amendment Under 37 CFR §1.116 should have properly been entered. Furthermore, it is extremely prejudicial to Applicants for the Examiner to refuse entry of Applicants' Amendment Under 37 CFR §1.116 that was filed on the six month response due date. By doing so, Applicants now have no means to comply with the requirement of placing the application into condition for allowance by the six month response due date.

Applicant therefore respectfully requests that Applicants' Amendment Under 37 CFR §1.116 be entered and that the Examiner consider the references cited in the Information Disclosure Statement submitted herewith.

No fees are believed to be due with this response. However, the Commissioner is hereby authorized to credit any overpayment or debit any additional fee that may be due in connection with this application to the deposit account of the undersigned, No. 23-3030, but not to include payment of any issue fees.

Respectfully submitted,

By: 
Troy J. Cole
Reg. No. 35,102
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456